REMARKS

Disposition of the Claims

Claims 1-44 were pending as of the present Office Action, which states that:

Claim 35 is objected to;

Claims 1-3, 9, 11, 13-15, 19, 24-27, and 29-34 are rejected under 35 U.S.C. 102(e) over U.S. Patent No. 6,068,183 to Freeman et al. (Freeman '183);

Claim 40 is rejected under 35 U.S.C. 102(e) over U.S. Patent No. 6,019,284 to Freeman et al. (Freeman '284);

Claims 4-6, 10, 12, 16 and 28 are rejected under 35 U.S.C. 103(a) over Freeman '183;

Claims 35-39 and 41-44 are rejected under 35 U.S.C. 103(a) over Freeman '284; and

Claims 7, 8, 17, 18 and 20-23 are rejected under 35 U.S.C. 103(a) over Freeman '183 in view of U.S. Patent No. 5,380,991 to Valencia et al. (Valencia).

Claim Amendments

By this Amendment, claim 16 has been amended to correct a minor clerical error; claims 21 and 23 have been amended to improve the grammar thereof; claim 35 has been amended to overcome the present objection thereof; and claims 1, 9, 20, 24, and 25 have been amended to more particularly point out and distinctly claim the invention.

Claim Objection

The office action indicates that claim 35 is objected to because of an inconsistency in terminology appearing in line 7 thereof relative to terminology used in line 3 thereof. By this Amendment, appropriate correction has been made. Accordingly, it is respectfully requested that the objection to claim 35 be reconsidered and withdrawn.

35 U.S.C. 102(e) Rejections

Claims 1-3, 9, 11, 13-15, 19, 24-27 and 29-34

The rejection of claims 1-3, 9, 11, 13-15, 19, 24-27 and 29-34 under 35 U.S.C. 102(e) over Freeman '183 is respectfully traversed based on the following.

Claims 1-3, 9, 11, 13-15, 19, 24, 25 and 26

Claim 1 of the present invention is directed to an electronic apparatus comprising "a rewritable display panel having memory capability; a reception device for receiving display information; an operational element operable by an operator; and a controller, responsive to said reception device, for controlling said display." The controller as recited in claim 1 of the present invention is "configured to control the display so that first display information associated with an operation of said operational element is displayed on said display panel when said operational element is operated."

Freeman '183 discloses a chip card (or a smart card) 10 on the top surface of which display elements 14a-14b are provided. One display element 14a displays a stored value (e.g. a seat number), while the other display element 14b displays other graphic information (e.g. theater seat map or directions to the theater)[1]. However, Freeman '183 fails to disclose an operational element operable by the operator and a controller being configured to control the display so that first display information associated with the operation of said operational element is displayed on said display panel when said operational element is operated as recited in claim 1 of the present invention.

Thus, Freeman '183 does not disclose, expressly, implicitly, or inherently, the operational element operable by the operator and the controller being configured to control the display so that the first display information associated with the operation of said operational element is displayed on said display panel when said operational element is

[1] Freeman '183, col. 3, lines 1-12.

operated as claimed in claim 1 of the present invention. Therefore, Freeman '183 cannot anticipate claim 1, or claims 2 and 3 which depend from claim 1.

Claim 9

Claim 9 of the present invention is directed to an electronic apparatus comprising "an operational element operable by an operator; [and] a first display portion for displaying first display information associated with an operation of said operational element." As pointed out above with regard to claim 1, Freeman '183 fails to disclose, expressly, implicitly, or inherently, an operational element operational by the operator and a first display portion for displaying first display information associated with the operation of said operational element. Therefore, based on the arguments presented above, Freeman '183 cannot anticipate claim 9, or claims 11, 13-15, and 19 which depend from claim 9.

Claim 24

Claim 24 of the present invention recites in part "a display controller for controlling information displayed on said display; and an operational element operable by an operator; wherein said controller is configured to display first display information associated with an operation of said operational element in a first portion of said display." As pointed out above with regard to claim 1, Freeman '183 fails to disclose, expressly, implicitly, or inherently, an operational element operable by the operator and a display controller for controlling information displayed on said display wherein said controller is configured to display first display information associated with the operation of said operational element in the first portion of said display. Therefore, based on the arguments presented above, Freeman '183 cannot anticipate claim 24.

Claim 25

Claim 25 of the present invention recites in part "a display controller for controlling information displayed on said display; and an operational element operable by an operator." Claim 25 further recites "wherein said controller is configured to display

first display information associated with an operation of said operational element in said display when said operational element is operated." As pointed out above with regard to claim 1, Freeman '183 fails to disclose, expressly, implicitly, or inherently, an operational element operable by the operator and a controller configured to display first display information associated with an operation of said operational element in said display when said operational element is operated. Therefore, based on the arguments presented above, Freeman '183 cannot anticipate claim 25, or claim 26 which depends from claim 25.

Claims 27 and 29-32

Claim 27 is directed to a communication terminal comprising "a controller for selecting either said first display portion or said second display portion...based on an identifier attached to received communication data."

Freeman '183 discloses a smart card having an integrated circuit and one or more displays[2]. The Office Action contends that the integrated circuit disclosed in Freeman '183 selects one of two display portions on which received image data is displayed. The Office Action then argues that it is inherent in the device described at Freeman '183, col. 3, lines 14-21, that the integrated circuit make the selection based on an identifier attached to the received image data. However, Applicants respectfully disagree.

It should be noted that while the inherent disclosure of a prior art reference may be relied on in order to support a rejection under 35 U.S.C. 102 or 103, the MPEP adds the condition that there must be provided "a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art."[3]

While it could be argued that Freeman '183 never discloses that the integrated circuit selects a display portion on which image data is displayed, in either case there is certainly no clear basis for contending that selecting a display on which to display data

[2] *Id.* at col. 5, lines 7, 8, 12-14, and 32-34.
[3] MPEP § 2112 (8th ed.)(citing *Ex parte Levy*, 17 USPQ2d 1461 (BPAI 1990)).

must inherently be based on an identifier attached to image data. For example, the decision as to how display data is displayed could be user-specified, as disclosed at Freeman '183, col. 4, lines 11-14.

Thus, Freeman '183 does not disclose, expressly, implicitly, or inherently, a controller for selecting a display portion based on an identifier attached to received communication data as recited in claim 27. Therefore, Freeman '183 cannot anticipate claim 27, or claims 29-32 which depend from claim 27.

Claim 33

Claim 33 recites in part "control means, responsive to the identifier attached to the received communication data, for selecting either said first display means or said second display means as a display on which received image data is displayed." As pointed out above with regard to claim 27, Freeman '183 does not disclose, expressly, implicitly, or inherently, a controller for selecting a display portion based on an identifier attached to received communication data. Therefore, based on the arguments presented above, Freeman '183 cannot anticipate claim 33.

Claim 34

Claim 34 is a method claim, which recites in part "communicating an identifier associated with said data to indicate that the image data is to be displayed on a display having a memory capability." For at least the same reasons discussed above with regard to claim 27, Freeman '183 cannot anticipate claim 34.

Accordingly, it is respectfully requested that the rejection of claims 1-3, 9, 11, 13-15, 19, 24-27 and 29-34 under 35 U.S.C. 102(e) be reconsidered and withdrawn.

Claim 40

The rejection of claim 40 under 35 U.S.C. 102(e) over Freeman '284 is respectfully traversed based on the following.

Claim 40 is directed towards a portable communication terminal, and recites in part "a controller for adjusting, based on a change in an input and output level of communication, timing of performing communication and timing of driving of said display device so as to limit a load on said power source."

Freeman '284 discloses a card having a display element and circuitry for controlling the display element. Freeman '284 discloses that the card also can include a power source and a kickstart circuit that controls the power source. The kickstart circuit provides power from the power source to other circuitry of the card when a user provides an input, such as pressing a contact area. The kickstart circuit continues to provide power for a predetermined period of time or until a subsequent input from a user. The kickstart circuit is disclosed in Freeman '284 as a way of conserving card energy.

On the other hand, Freeman '284 fails to disclose the use of the kickstart circuit for controlling the timing of communication and display, and fails to disclose the use of the display control circuitry so as to limit a load on the power source. Further, Freeman '284 fails to even suggest a control of any sort based on **changes** in input and output **levels of communication**. Therefore, since Freeman '284 fails to disclose or suggest all of the limitations of claim 40, Freeman '284 cannot anticipate claim 40.

Accordingly, it is respectfully requested that the rejection of claim 40 under 35 U.S.C. 102(e) be reconsidered and withdrawn.

35 U.S.C. 103(a) Rejections

Claims 4-6, 10, 12, 16, and 28

The rejection of claims 4-6, 10, 12, 16, and 28 under 35 U.S.C. 103(a) over Freeman '183 is respectfully traversed based on the following.

Claims 4-6

Claims 4-6 depend from claim 1, and therefore include all of the limitations of claim 1. As pointed out above, Freeman '183 does not disclose, expressly, implicitly, or inherently, the operational element operable by the operator and the controller being configured to control the display so that the first display information associated with the operation of said operational element is displayed on said display panel when said operational element is operated as claimed in claim 1 of the present invention. It is similarly true that Freeman '183 does not suggest the operational element operable by the operator and the controller being configured to control the display so that the first display information associated with the operation of said operational element is displayed on said display panel when said operational element is operated as claimed in claim 1 of the present invention. Therefore, Freeman '183 cannot render obvious claim 1, or claims 4-6 which depend from claim 1.

Claims 10, 12 and 16

Claims 10, 12 and 16 depend, directly or indirectly, from claim 9, and therefore include all of the limitations of claim 9. As pointed out above, Freeman '183 fails to disclose, expressly, implicitly, or inherently, an operational element operational by the operator and a first display portion for displaying first display information associated with the operation of said operational element as claimed in claim 9 of the present invention. It is similarly true that Freeman '183 does not suggest an operational element operational by the operator and a first display portion for displaying first display information associated with the operation of said operational element as claimed in claim 9 of the

present invention. Therefore, Freeman '183 cannot render obvious claim 9, or claims 10, 12 and 16 which depend from claim 9.

Claim 28

Claim 28 depends from claim 27. As pointed out above with regard to claim 27, Freeman '183 does not disclose, expressly, implicitly, or inherently, a controller for selecting a display portion based on an identifier attached to received communication data as recited in claim 27. Since claim 28 depends from claim 27, this is true for claim 28 as well.

Also, claim 28 adds that the communication terminal further comprises a reception notification sound generator. The Office Action correctly points out that Freeman '183 teaches a speaker 17. However, Freeman '183 is silent with regard to using the speaker 17 for reception notification. Claim 28 also adds that under certain conditions, generation of a reception notification sound is inhibited.

The Office Action contends that, while Freeman '183 does not specifically teach this feature, it would be obvious based on Freeman col. 5, lines 44-52. Applicants respectfully disagree. The cited portion of Freeman '183 refers to a feature allowing a card owner to disable the receipt of data, and different ways of implementing the blocking of incoming data. If incoming data were blocked, there would be no need to disable an incoming data notification sound. Considering that Freeman '183 is silent with regard to incoming data notification sounds, and the cited excerpt would eliminate the need for inhibiting the sound rather than leading one skilled in the art to consider implementing a sound inhibitor, Freeman '183 cannot render claim 28 obvious.

Accordingly, it is respectfully requested that the rejection of claims 4-6, 10, 12, 16 and 28 under 35 U.S.C. 103(a) be reconsidered and withdrawn.

Claims 35-39 and 41-44

The rejection of claims 35-39 and 41-44 under 35 U.S.C. 103(a) over Freeman '284 is respectfully traversed based on the following.

Claims 35-39

Claim 35 recites in part:

> a power source for supplying power to said communications means and said means for driving said display device; and
> a controller for inhibiting simultaneous performing of communication and updating of at least a portion of said display device so as to limit a load on said power source.

Freeman '284 is directed to a smart card that can include a kickstart circuit to conserve power. The kickstart circuit allows the card to conserve power by providing power to the card when a user is using the card. Freeman '284 also discloses that the circuit can provide power to the card for predetermined periods of time. Thus, the idea in Freeman '284 is to prevent wasted power usage by trying to supply power to the card only when the card is in use.

On the other hand, claim 35 includes a controller that limits the load on a power source by inhibiting simultaneous operations. This is much different than preventing wasted power usage by trying to supply power to the card only when the card is in use as taught by Freeman '284. In short, Freeman '284 fails to provide any suggestion of inhibiting simultaneous operations. Therefore, Freeman '284 cannot render obvious claim 35, or claims 36-39 which depend from claim 35.

Claims 41-44

Claims 41-44 depend from claim 40. As stated above with regard to claim 40, Freeman '284 fails to disclose the use of the kickstart circuit for controlling the timing of communication and display, and fails to disclose the use of the display control circuitry so

as to limit a load on the power source. Further, Freeman '284 fails to even suggest a control of any sort based on **changes** in input and output **levels of communication**. Therefore, since Freeman '284 fails to disclose or suggest all of the limitations of claim 40, Freeman '284 cannot anticipate or render obvious claim 40, or claims 41-44 which depend from claim 40.

Accordingly, it is respectfully requested that the rejection of claims 35-39 and 41-44 under 35 U.S.C. 103(a) be reconsidered and withdrawn.

Claims 7, 8, 17, 18, and 20-23

The rejection of claims 7, 8, 17, 18, and 20-23 under 35 U.S.C. 103(a) over Freeman '183 in view of Valencia is respectfully traversed based on the following.

Claim 20

Claim 20 of the present invention is directed to a method of placing an advertisement on an electronic apparatus having a display panel having memory capability and a controller for controlling said display panel. The method as claimed in claim 20 comprises the step of determining whether at least one predetermined service condition has been received, wherein said predetermined service condition is selected from the group including a purchase price discount service of said electronic apparatus, a usage charge discount service of said electronic apparatus, and a predetermined payment contract of said electronic apparatus.

On the other hand, Freeman '183 is directed to a smart car having a display that can display advertisements and the like. Valencia is directed to a smart card having an erasable memory that contains information relating to a discount coupon amount as well as information relating to particular products which have been purchased. The smart card disclosed by Valencia is inserted into an appropriate terminal scanner provided at a retailer's checkout counter. Purchased items and the smart card are scanned, and information relating to the scanned items is sent to a main computer that compares the

purchased items to those items on which a discount is to be applied, and then a discount amount is deducted from the purchaser's receipt total, as well as from the total amount of discounts included on the smart card[4]. However, neither of these references, that is Freeman '183 and Valencia, is concerned with determining whether at least one predetermined service condition has been received which is selected from the group including the purchase price discount service of said electronic apparatus, the usage charge discount service of said electronic apparatus, and the predetermined payment contract of said electronic apparatus.

Thus, even if one skilled in the art were to consider combining Freeman '183 and Valencia, the resulting combination would still fail to disclose or suggest anything concerned with a method for determining whether at least one predetermined service condition has been received which is selected from the group including the purchase price discount service of said electronic apparatus, the usage charge discount service of said electronic apparatus, and the predetermined payment contract of said electronic apparatus as recited in claim 20 of the present invention. Therefore, since the combination of Freeman '183 and Valencia fails to disclose or suggest all of the limitations of claim 20, the combination of Freeman '183 and Valencia cannot render obvious claim 20.

Claims 7 and 8

Claims 7 and 8 depend, directly or indirectly, from claim 1, and therefore include all of the limitations of claim 1. As pointed out above, Freeman '183 does not disclose or suggest the operational element operable by the operator and the controller being configured to control the display so that the first display information associated with the operation of said operational element is displayed on said display panel when said operational element is operated as claimed in claim 1 of the present invention. Valencia, discussed above, does not suggest a display on the smart card discussed therein, does not suggest an operational element operable by the operator on the smart card, and thus also fails to suggest a controller being configured to control a display so that display

[4] Valencia, col. 3, lines 13-29.

information associated with the operation of said operational element is displayed on said display panel when said operational element is operated as claimed in claim 1 of the present invention.

Thus, even if one skilled in the art were to consider combining Freeman '183 and Valencia, the resulting combination would still fail to disclose or suggest anything concerned with the operational element operable by the operator and the controller being configured to control the display so that the first display information associated with the operation of said operational element is displayed on said display panel when said operational element is operated as claimed in claim 1 of the present invention. Therefore, since the combination of Freeman '183 and Valencia fails to disclose or suggest all of the limitations of claim 1, the combination of Freeman '183 and Valencia cannot render obvious claim 1, or claims 7 and 8 which depend, directly or indirectly, from claim 1.

Claims 17 and 18

Claims 17 and 18 depend, directly or indirectly, from claim 9, and therefore include all of the limitations of claim 9. As discussed above, Freeman '183 and Valencia fail to disclose or suggest an operational element operational by the operator and a first display portion for displaying first display information associated with the operation of said operational element as claimed in claim 9 of the present invention. Therefore, since the combination of Freeman '183 and Valencia fails to disclose or suggest all of the limitations of claim 9, the combination of Freeman '183 and Valencia cannot render obvious claim 9, or claims 17 and 18 which depend, directly or indirectly, from claim 9.

Claims 21 and 22

By this Amendment, claim 21 has been amended to recite in part:

> A system for **determining a usage charge for use of an electronic apparatus**...said system comprising:
>
> ...

> **a counter for counting the usage charge** based on a use condition of said electronic apparatus; and
>
> **subtraction means for reducing the usage charge** based on the registered information.[5]

Thus, according to claim 21, a system is provided for determining a usage fee for the use of some electronic apparatus. The system includes a counter and a subtraction means.

Claim 21 is presently rejected over the combination of Freeman '183 and Valencia. Freeman '183 is directed to a smart card having a display that can display advertisements and the like. Valencia is directed towards a smart card that is used in conjunction with a discount program at a retail facility. Valencia discloses that the smart card stores an amount of discounts a shopper has remaining, and when the smart card is used, the smart card is swiped through a terminal that updates the amount of discounts remaining on the smart card and provides the shopper with discounts as appropriate from their purchases. However, neither of these references, that is Freeman '183 and Valencia, is concerned with determining a usage charge for an electronic apparatus of some sort.

Thus, even if one skilled in the art were to consider combining Freeman '183 and Valencia, the resulting combination would still fail to disclose or suggest anything concerned with a system for determining a usage charge for an electronic apparatus, particularly a counter for counting the usage charge or a subtraction means for reducing the usage charge as recited in claim 21. Therefore, since the combination of Freeman '183 and Valencia fails to disclose or suggest all of the limitations of claim 21, the combination of Freeman '183 and Valencia cannot render obvious claim 21, or claim 22 which depends from claim 21.

[5] Emphasis added.

Claim 23

By this Amendment, claim 23 has been amended to recite in part:

> A method of charging a usage charge for use of an electronic apparatus provided with a display panel having memory capability, said method comprising the steps of:
>
> ...
>
> (3) counting the usage charge based on a use condition of said electronic apparatus;
>
> (4) reducing the usage charge based on the registered information; and
>
> (5) charging a user based on the reduced usage charge.

Thus, claim 23 is a method claim reciting limitations that correspond to those discussed above with regard to claim 21. Therefore, the arguments presented above with regard to claim 21 apply equally to claim 23. Accordingly, for at least the same reasons discussed above, the combination of Freeman '183 and Valencia cannot render obvious claim 23.

Accordingly, it is respectfully requested that the rejection of claims 7, 8, 17, 18 and 20-23 under 35 U.S.C. 103(a) be reconsidered and withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.

This Amendment does not increase the number of independent claims, does not increase the total number of claims, and does not present any multiple dependency claims. Accordingly, no fee based on the number or type of claims is currently due. However, if a fee, other than the issue fee, is due, please charge this fee to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260.

If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

Any other fee required for such Petition for Extension of Time and any other fee required by this document, other than the issue fee, and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

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June 2, 2003

DA1 255675v5